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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/652,115	08/30/2003	James J. O'Connor	0020-3 CIP	1836
25901	7590	04/20/2005		EXAMINER
ERNEST D BUFF & ASSOCIATES, LLC 245 SOUTH ST MORRISTOWN, NJ 07960			JAGAN, MIRELLYS	
			ART UNIT	PAPER NUMBER
			2859	

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/652,115	O'CONNOR, JAMES J.
	<b>Examiner</b>	<b>Art Unit</b>
	Mirellys Jagan	2859

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

#### A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 01 April 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,2 and 5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,2 and 5 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 30 August 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments, filed 4/1/05, with respect to the rejection(s) of claim(s) 1, 2, and 5 based on U.S. Patent 5,598,638 to Plesh have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of U.S. Patent 2,713,203 to Gottlieb and U.S. Patent 5,222,303 to Jardine.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 2,713,203 to Gottlieb in view of U.S. Patent 5,222,303 to Jardine.

Gottlieb discloses an apparatus comprising:

an elongated body with first and second ends and front and back sides, the first end having a width of 2-4 inches (substantially 4 inches);  
a plurality of slots disposed on the body at a plurality of locations, each slot determining placement of a cut line and being located at a location on the body that conforms to building laws and other requirements, i.e., codes and standards; and

a set of indicia located along each edge of the front side for indicating the distance of the slots from the first end.

Gottlieb teaches that the distance of the slots from the first end can be indicated on the front side by any desired indicia, and that the apparatus may have text for indicating instructions and guidelines to allow and individual using the apparatus to conform to building laws and other requirements.

Furthermore, as stated above, the slots are disposed at a plurality of locations and each slot is located at a location on the body that conforms to building laws and other requirements, i.e., codes and standards. Therefore, the slots are disposed such that a single electrical box may be located at different heights unrelated to each other, i.e., if a user places or positions a box along a line drawn at each slot, the box will be located at different heights that are unrelated to each other, and the location of the box will be in accordance with the codes and standards of the slot, i.e., the location of the box is in compliance with the standards and codes of the slot (see column 23, line 68-column 4, line 10; and column 4, lines 25-35).

Gottlieb does not disclose the apparatus having a level for vertically leveling the apparatus.

Jardine discloses a measuring apparatus for marking and locating the position of a cut line on a wall. The apparatus has levels (26, 28) thereon for properly positioning the apparatus vertically and horizontally, thereby allowing accurate markings to be drawn on a wall.

Referring to claim 1, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus disclosed by Gottlieb by adding levels

to the apparatus, as taught by Jardine, in order to properly position the apparatus and draw lines more accurately.

***Response to Arguments***

4. Applicant's arguments with respect to claims 1, 2, and 5 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

5. The new grounds of rejections presented in this Office action are based on the same claims of Applicant's amendment, filed 10/25/04, which necessitated the new ground(s) of rejection presented in the final Office action, dated 1/10/05. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 2859

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mirellys Jagan whose telephone number is 571-272-2247. The examiner can normally be reached on Monday-Friday from 11AM to 4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez can be reached on 571-272-2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJ  
April 12, 2005

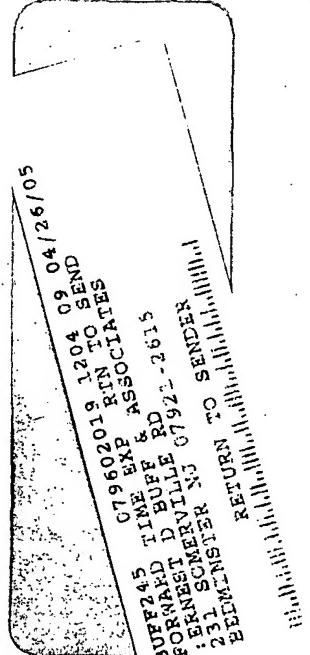
*G. Verbitsky*  
GAIL VERBITSKY  
PRIMARY EXAMINER

Organization **TC2800** Bldg/Room **Jeff**  
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